

The opinion in support of the decision being entered today was not written  
for publication and is not binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

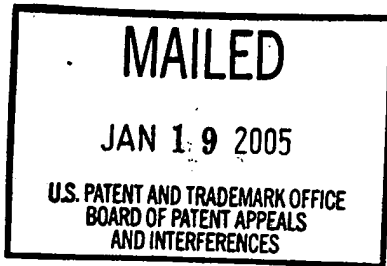
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte AXEL SCHUMACHER

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Appeal No. 2004-2042  
Application No. 10/019,269

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HEARD: January 12, 2005

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Before COHEN, NASE, and BAHR, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 8 to 25,  
which are all of the claims pending in this application.

We REVERSE.

### BACKGROUND

The appellant's invention relates to a method for actuating a wheel brake assembly, in particular an electromechanical wheel brake assembly or a mechanical system involving friction and having spring elasticity (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

Claims 8 to 25 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 8 to 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,090,518<sup>1</sup> to Schenk et al. (Schenk).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed April 2, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed December 19, 2003) for the appellant's arguments thereagainst.

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<sup>1</sup> Issued February 25, 1992.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the Schenk patent, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

#### **The indefiniteness rejection**

We will not sustain the rejection of claims 8 to 25 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

Furthermore, the appellant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 213-14, 169 USPQ 226, 228-29 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. In addition, breadth of a claim is not to be equated with indefiniteness. See In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

With this as background, we analyze the specific rejection under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal. The sole basis for this rejection (answer, p. 3) is that it was unclear what the word "imperceptible" as used in independent claims 8, 9 and 20 meant.<sup>2</sup> We do not agree. In our view, the scope of the word "imperceptible" as used in independent claims 8, 9 and 20 can be determined from the language of the claims with a reasonable degree of certainty from the teachings of the appellant's application as it would be interpreted by one possessing the ordinary level of skill in the pertinent art as set forth on pages 5-7 of the brief. The word "imperceptible" as used in independent claims 8, 9 and 20 means that the period of time of the actuation in the release direction is only so brief that any stresses in the drive of the assembly will be reversed and that the static friction will change into a sliding friction so that the reduction in force cannot be perceived (e.g., by the driver applying the braking force).

For the reasons set forth above, the decision of the examiner to reject claims 8 to 25 under 35 U.S.C. § 112, second paragraph, is reversed.

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<sup>2</sup> Claim 8 includes the recitation "said brief period of time of the actuation in the release direction being selected to be so short that any reduction of the braking force is imperceptible." Claim 9 includes the recitation "the period of time of the actuation in the release direction being selected to be so short that any reduction of the force exerted is imperceptible." Claim 20 includes the recitation "said brief period of time of the actuation in the release direction being selected to be so short that any reduction of the braking force is imperceptible."

### **The anticipation rejection**

We will not sustain the rejection of claims 8 to 25 under 35 U.S.C. § 102(b) as being anticipated by Schenk.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

The examiner's position (answer, pp. 3-6) is that the method claimed is relatively broad and appears to read on the well-known anti-lock brake system of Schenk wherein the brakes are actuated and released intermittently and/or repeatedly in a brief period of time so as the wheel does not slip or lock on different road surface conditions.

The appellant argues (brief, pp. 9-13) that there is no teaching in Schenk that the period of time the braking force is reduced is selected to be so short that any reduction of the braking force is imperceptible as required by claims 8, 9 and 20. We agree. In that regard, Schenk does not disclose that the period of time of the actuation in the release direction is only so brief that any stresses in the drive of the assembly will be reversed and that the static friction will change into a sliding friction. Thus, Schenk does not teach that the period of time the braking force is reduced is selected to be so short that any reduction of the braking force is imperceptible as required by claims 8, 9 and 20.

Since the "imperceptible" limitation as used in independent claims 8, 9 and 20 is not taught by Schenk, the decision of the examiner to reject claims 8, 9 and 20, and claims 10 to 19 and 21 to 25 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 8 to 25 under 35 U.S.C. § 112, second paragraph, is reversed; and the decision of the examiner to reject claims 8 to 25 under 35 U.S.C. § 102(b) is reversed.

REVERSED



IRWIN CHARLES COHEN  
Administrative Patent Judge



JEFFREY V. NASE  
Administrative Patent Judge



JENNIFER D. BAHR  
Administrative Patent Judge

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